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Customer No. 32127

REMARKS

Applicant submits this Response in response to the Office Action mailed March 25, 2005. In this Response, Applicant has amended claims, 20, 23-25, 35, 38 and 41-43, has canceled claims 21, 22, 26-33, 36, 37, 39, 40 and 44, and has added new claims 45-55. Claims 1-18 (withdrawn), 20, 23-25, 35, 38, 41-43 and 45-55 are currently pending. No new matter has been added.

In the Office Action, the Examiner has rejected claims 20-23, 26, 28, 30, 32 and 41 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,950,173 to Perkowski ("Perkowski"), in view of U.S. Patent No. 6,490,367 to Carlsson et al. ("Carlsson") and the Science article titled "New Language Could Meld the Web Into a Seamless Database," by Dana MacKenzie, dated June 19, 1998 ("MacKenzie"). The Examiner has also rejected claims 24-25 under 35 U.S.C. § 103 as being unpatentable over Perkowski in view of Carlsson, MacKenzie, and U.S. Patent No. 6,269,446 to Schumacher et al. ("Schumacher"). The Examiner has also rejected claims 27, 29, 31 and 33 under 35 U.S.C. § 103 as being unpatentable over Perkowski in view of Carlsson, MacKenzie, Schumacher and the InfoWorld article titled "Organize files on your internet or intranet server for distribution," by Mike Heck, dated January 12, 1998 ("Heck"). The Examiner has also rejected claims 35-37 under 35 U.S.C § 103 as being unpatentable over Perkowski in view of Carlsson, MacKenzie and Heck. The Examiner has also rejected claim 38 under 35 U.S.C. § 103 as being unpatentable over Perkowski in view of Carlsson, MacKenzie and Heck. The Examiner has also rejected claim 39 under 35 U.S.C. § 103 as being unpatentable over Perkowski in view of Carlsson, MacKenzie and the Business Wire article entitled "Diamond Head's tempest server version 2.1 to be used to store over twenty million images," dated March 1, 1999 ("Diamond Head"). The Examiner has also rejected claim 40 under 35 U.S.C. § 103 as being unpatentable over Perkowski in view of Carlsson, MacKenzie and Schumacher. The Examiner has also rejected claims 42 and 43 under 35 U.S.C. § 103 as being unpatentable over Perkowski in view of Carlsson and McKenzie. Applicant traverses these rejections and respectfully requests that the Examiner withdraw these rejections based upon the following.

I.   Examiner's Responses to Applicant Arguments

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In ¶ 3 of the Office Action, the Examiner has provided responses to various arguments made by Applicant in a previous response. Applicant will address certain of these responses in the course of responding to the rejections set forth in the Office Action. However, Applicant takes note that the Examiner has presented various sections of U.S. Patent No. 6,038,601 to Lambert et al. ("Lambert"), asserting that "Lambert's TOC catalog is an electronic document and that is within claim 20's meanings." (Office Action, p. 4.) The Examiner does not rely upon Lambert in any of the rejections set forth in the current Office Action (although the Examiner has relied upon Lambert to support claim rejections in prior office actions). To the extent that the Examiner is asserting that Lambert describes the subject matter of claim 20, Applicant respectfully disagrees with such assertion, based on the actual descriptions provided in Lambert. However, since the Examiner has not relied upon Lambert in the Office Action (and therefore has not provided any analysis of Lambert in this Office Action with respect to the pending claims), Applicant does not further address Lambert in this response.

Applicant also notes that the Examiner has argued that claim 20 recites "only 2 essential steps: providing/processing information and verifying content in a method of providing an electronic catalog." Applicant must object this characterization of claim 20; the Examiner's interpretation of claim 20 would impermissibly read out of claim 20 most of the limitations recited by claim 20. If the Examiner persists in this characterization, Applicant respectfully requests that the Examiner provide some legal precedent for such an extraordinary reading of the pending claims.

II.   Rejections Under § 103

In ¶¶ 4-11 of the Office Action, the Examiner has rejected claims 20-33 and 35-44 under 35 U.S.C. § 103 as obvious in view of various combinations of cited references (as noted above). As Applicant has canceled claims 21, 22, 26-33, 36, 37, 39, 40 and 44, the rejections of these claims are moot. Applicant respectfully requests that the Examiner reconsider the rejections of

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the remaining claims – and favorably consider new claims 45-55 – based on the discussion below.[1]

i. *The Perkowski Reference*

The Perkowski reference describes a "consumer-product information collection, transmission and delivery system." (Perkowski, col. 11, ll. 34-35.) The system is described as using an Internet Product Finding Directory (IPD) server, which stores records containing Universal Product Code (UPC) numbers for products and related URLs to the product manufacturer's web site. (Id., col. 18, ll. 33-49.) Users of the system can search for product information by specifying the product's UPC number in a browser, which is then provided to the IPD server. (Id., col. 22, ll. 33-39.) The IPD server checks for any record corresponding to the specified UPC number. (Id., col. 18, lines 40-43.) If a record exists, the URL in the record is then sent from the IPD server to the user's client system. (Id., col. 18, ll. 48-49.)

The Examiner asserts that Perkowski "teaches an environment of e-commerce, wherein product ordering and/or payment information, and an offer to sell entry and/or an offer to buy entry are discussed, an environment of e-commerce, wherein product ordering or payment method information, and an offer to sell entry or an offer to buy entry are discussed; in summary, Perkowski provides related information (see Perkowski, 10:53 to 11:33.)" (Office Action, p. 6.) To the extent this assertion is understood by Applicant, Applicant is unclear how an "environment of e-commerce" as stated by the Examiner corresponds to the specific claim elements recited in the pending claims. Moreover, the portion of Perkowski cited by the Examiner for supporting this analysis includes no discussion of "entries" for ordering methods or payment methods.[2] At best, the system described in Perkowski allows a user to use a UPC

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[1]   As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner with respect to these rejections and certain requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, and so forth) is not a concession by Applicant that such assertions are correct or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

[2]   The portion of Perkowski cited by the Examiner describes the structural components of the system described in Perkowski (shown in block diagram form in Figure 1), and their general interconnection. (Id., col. 10, l. 53 to col. 11, l. 33.) None of the discussion in this portion of Perkowski describes entries in an electronic document for ordering methods or payment methods. To the extent the Examiner disagrees, Applicant requests that the Examiner identify the structure described in this portion of Perkowski that allegedly reads on these claim elements so that Applicant can adequately respond.

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number or product name to search a remote database to retrieve a URL associated with the product (described in Perkowski as being the URL for the manufacturer of the product). In fact, when the Examiner performed an element-by-element correlation of the claim elements to the system described in Perkowski, such an analysis indicated that many elements from the pending claims are missing from the system described in Perkowski. For example:

> Perkowski does not expressly disclose about:
> - providing sourcing information, and a payment method information in a header section;
> - providing an entry in a body section of an electronic document, wherein that entry is corresponding to a sale from an above source; (the examiner submits that such entry is normally available/provided from an online source);
> - providing information to verifying a document content in that document's footer section;
> - Interactively performing communications (i.e., responding to requests for content verification, and responding to a user's selection). (Office Action, p. 6-7.)

Applicant respectfully submits that these assertions by the Examiner belie the rationale for the rejections of the pending claims. Applicant's review of Perkowski likewise indicates that Perkowski does not describe at least the following subject matter:

- storing source information of the source of an electronic catalog in the electronic catalog;

- storing ordering method information or payment method information in the electronic catalog;

- storing object entries in the electronic catalog, the object entries corresponding to objects available for sale by and/or purchase by the source of the electronic catalog;

- storing verification information for verifying the authenticity of the electronic catalog in the electronic catalog, the verification information at least partially based on the header and body sections (for example, a digital signature);

- generating a second electronic catalog that includes a first electronic catalog having any of the information listed above.

To the extent the Examiner asserts any portion of Perkowski teaches any of the claimed elements, Applicant respectfully requests that the Examiner specifically identify those portions and the claim element allegedly taught thereby, so that Applicant may respond to the Examiner's assertions and advance prosecution of this application.

  ii. *The Carlsson Reference*

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The Carlsson reference describes a "system for administering certificates" that includes a certification authority (CA) "centre" and a "CA terminal." (Carlsson, Abstract, col. 5, ll. 41-52.) The CA terminal is used by administrators to obtain certificates for users, which can includes the user's name, department, company, country and a "period of validity." (Id., col. 9, ll. 45-55.) This information is provided to the CA centre, which "verifies the integrity of the transmitted certificate data," add supplementary information to the certificate data (e.g., a public key) and sends the completed certificate to the CA terminal. (Id., col. 8, ll. 38-47.) The transmissions between the CA centre and the CA terminal are secured using digital signatures of the CA centre and the administrator. (Id., col. 8, ll. 34-37, 45-47.) The Carlsson reference thus describes a process by which a digital certificate can be securely created over a distributed system having a centralized certificate authority and remote terminals for administrative access.

The Carlsson reference actually describes almost none of the elements of the pending claims. For example, Carlsson provides no descriptions of at least the following subject matter:

- storing source information of the source of an electronic catalog in the electronic catalog;
- storing ordering method information or payment method information in the electronic catalog;
- storing object entries in the electronic catalog, the object entries corresponding to objects available for sale by and/or purchase by the source of the electronic catalog;
- storing verification information for verifying the authenticity of the electronic catalog in the electronic catalog, the verification information at least partially based on the header and body sections (for example, a digital signature);
- generating a second electronic catalog that includes a first electronic catalog having any of the information listed above.

At best, Carlsson describes the digital signing of transmissions between the CA centre and the CA terminals in the course of creating a digital certificate. Carlsson does not describe the use of a digital signature in connection with an electronic catalog such as recited in the pending claims.

iii.   The MacKenzie Reference

The MacKenzie reference notes the existence of Extensible Markup Language (XML). (MacKenzie, p. 1, ll. 13-17.) MacKenzie further explains that XML uses user-definable "tags"

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to identify the semantics of a document (i.e., the meaning of the contents). (Id., pg. 2, ll. 14-16.) The Examiner asserts that MacKenzie "sufficiently teaches about providing a verifiable electronic catalog in a computer environment, comprising about missing ideas from Perkowski's invention (see Mackenzie pg. 2: 3-7 and 18-20)." (Office Action, p. 7.) Applicant notes, however, that MacKenzie makes no mention of a header, body or footer section in an electronic document, but simply describes the basic concept of XML: that groups of users may define the semantics of their own tags, limited only by the syntax prescriptions. (MacKenzie, p. 2, ll. 14-17.) Thus, the MacKenzie reference actually describes almost _none_ of the elements of the pending claims,[3] for example:

- storing source information of the source of an electronic catalog in the electronic catalog;
- storing ordering method information or payment method information in the electronic catalog;
- storing object entries in the electronic catalog, the object entries corresponding to objects available for sale by and/or purchase by the source of the electronic catalog;
- storing verification information for verifying the authenticity of the electronic catalog in the electronic catalog, the verification information at least partially based on the header and body sections (for example, a digital signature);
- generating a second electronic catalog that includes a first electronic catalog having any of the information listed above.

Thus, at best, MacKenzie notes that XML uses user-defined tags – but gives no description of how such tags might be defined for use in an electronic catalog.

    iv.   *The Schumacher and Heck references*[4]

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[3] Of course, the storage of the information recited in the claim elements (e.g., verification information) could be implemented in an electronic catalog that uses XML tags. (See Specification, Detailed Description of the Preferred Embodiment(s), p. 12.) However, MacKenzie does not describe such tags or information, and therefore does not teach or suggest these claim elements.

[4] The Examiner has also cited the Diamond Head reference in rejecting claim 39. As Applicant has canceled claim 39, Applicant does not address the Diamond Head reference in this Response, but reserves the right to review the Examiner's assertions as to this reference in the future. Applicant does note however, that the Diamond Head reference appears not to be prior art to the present application, as its publication date is less than one year before the filing date.

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The Examiner has relied upon the Schumacher reference to show "a method of providing a digital signature in a footer of an electronic catalog." (Office Action, p. 13.) Schumacher describes a system that performs "public key/private key authentication of images from digital camera with global positioning system (GPS) data." (Schumacher, col. 1, ll. 8-10.) After a camera user takes a picture (and the camera captures image data from its sensor and time and location data from its GPS unit), a message digest is generated using a hashing function applied to the image data, time stamp, location, and camera information. (Id., col. 4, ll. 26-46.) The camera then encrypts the message digest with a private key, and stores the encrypted message digest in a header portion of the image file. (Id., col. 4, ll. 47-48, col. 5, ll. 2-3.) To verify the authenticity of the image file, a public key is obtained from a trusted party, and used to decrypt the encrypted message digest. (Id., col. 5, ll. 23-28.) The hashing function is applied to the original data in the image file, and if the message digest is the same as the results of the hashing function, the data is authentic. (Id., col. 5, ll. 28-35.)

Applicant notes that Schumacher does not describe an electronic catalog, and accordingly does not describe method steps related to generating an electronic catalog, such as:

- storing source information of the source of an electronic catalog in the electronic catalog;
- storing ordering method information or payment method information in the electronic catalog;
- storing object entries in the electronic catalog, the object entries corresponding to objects available for sale by and/or purchase by the source of the electronic catalog;
- storing verification information for verifying the authenticity of the electronic catalog in the electronic catalog, the verification information at least partially based on the header and body sections (for example, a digital signature);
- generating a second electronic catalog that includes a first electronic catalog having any of the information listed above.

At best, Schumacher describes a system and method that provides for digital signatures in the header of electronic image files that include GPS and other camera data. Such electronic image files do not, however, include the elements of an electronic catalog such as described in the present application (and recited in the claims).

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The Examiner has also relied upon the Heck reference, apparently asserting that the Heck reference teaches "determining [if the] catalog's information is current," and "update/modifying said electronic catalog." (Office Action, p. 13.) The Heck reference describes a software application ("FileCenter 1.0") which creates a database of each file in a library of a web site, indexes all words in these files, and creates Active Server pages to display those files that match a user's search request. (Heck, p. 1.) The web pages can include customized headers and footers, and can be pre-generated for anticipated requests. (Id., p. 1-2.) Thus the Heck reference merely describes storage of file information in a database, and the composition of web pages using the file contents. The Heck reference does not describe any updating or modifying of an electronic catalog, as asserted by the Examiner, and in fact describes almost none of the method steps related to generating an electronic catalog, such as:

- storing source information of the source of an electronic catalog in the electronic catalog;
- storing ordering method information or payment method information in the electronic catalog;
- storing object entries in the electronic catalog, the object entries corresponding to objects available for sale by and/or purchase by the source of the electronic catalog;
- storing verification information for verifying the authenticity of the electronic catalog in the electronic catalog, the verification information at least partially based on the header and body sections (for example, a digital signature);
- generating a second electronic catalog that includes a first electronic catalog having any of the information listed above.

v.   *The patentability of the claims in view of the art cited by the Examiner*

In contrast to the references cited by the Examiner, claim 20 of the present application recites a method that includes:

electronically storing sourcing information for a source of the electronic catalog and at least one of ordering method information and payment method information in a header section of the electronic catalog;

electronically storing object entries in a body section of the electronic catalog, the object entries corresponding to objects available for at least one of sale by and purchase by the source of the electronic catalog;

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electronically generating verification information that is usable to verify
the authenticity of the header and body sections of the electronic catalog, the
verification information at least partially based on the header and body sections;
storing the verification information in a footer section of the electronic
catalog;
transmitting the electronic catalog to a remote location.

As noted in the discussion of the cited references above, none of the list of references

cited by the Examiner – Perkowski, MacKenzie, Carlsson, Schumacher or Heck – either

taken individually or in any combination, teaches or suggests all of the elements of claim

20. For example, none of the cited references teaches or suggests storing sourcing

information for a source of the electronic catalog and at least one of ordering method

information and payment method information in a header section of the electronic

catalog, or storing object entries in a body section of the electronic catalog, the object

entries corresponding to objects available for at least one of sale by and purchase by the

source of the electronic catalog, as recited in claim 20. The absence of these elements (or

others) from the prior art precludes any anticipation or obviousness of claim 20.

Applicant therefore believes claim 20 to be patentable over Perkowski, MacKenzie,

Carlsson, Schumacher and Heck, and respectfully requests that the Examiner indicate the

allowance of claim 20. As claims 23-25, 35, 38 and 41-43 depend from claim 20, and

therefore include all of the limitations of claim 20, Applicant believes these claims to be

patentable over the references cited by the Examiner for at least the same reasons as

claim 20, and therefore respectfully requests that Examiner indicate allowance of claims

23-25, 35, 38 and 41-43 as well.[5]

In further contrast to the references cited by the Examiner, claim 45 recites a method that

includes:

receiving a first electronic catalog, the first electronic catalog including
first source information indicating a source of the first electronic
catalog,
at least one object entry containing first object information,

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[5]   As Applicant's remarks with respect to the base independent claim are sufficient to overcome the
Examiner's rejections of all claims dependent therefrom, Applicant's silence as to the Examiner's assertions with
respect to dependent claims is not a concession by Applicant to the Examiner's assertions as to these claims, and
Applicant reserves the right to analyze and dispute such assertions in the future.

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      first authenticity information indicating that the first source information and first object information is authentic, the first authenticity information at least partially based on the first source information and the first object information;

      generating a second electronic catalog, the second electronic catalog including

          the first electronic catalog,

          second source information indicating a source of the second electronic catalog,

          at least one second object entry containing second object information, the second object information referring to the first object information,

          second authenticity information indicating that the second source information and second object information is authentic, the second authenticity information at least partially based on the first electronic catalog, the second source information and the second object information;

      transmitting the second electronic catalog to a remote location.

As noted in the discussion of the cited references above, none of the list of references cited by the Examiner (Perkowski, MacKenzie, Carlsson, Schumacher and Heck) either taken individually or in any legally permissible combination, teaches or suggests all of the elements of claim 45. For example, none of the cited references teaches or suggests generating a second electronic catalog that includes the first electronic catalog, second source information, second object information and second authenticity information, as recited in claim 45. The absence of these elements (or others) from the prior art precludes any anticipation or obviousness of claim 45. Applicant therefore believes claim 45 to be patentable over Perkowski, MacKenzie, Carlsson, Schumacher and Heck, and respectfully requests that the Examiner indicate the allowance of claim 45. As claims 46-52 depend from claim 45, and therefore include all of the limitations of claim 45, Applicant believes these claims to be patentable over the references cited by the Examiner for at least the same reasons as claim 45, and therefore respectfully requests that Examiner indicate allowance of claims 46-52 as well.

In further contrast to the references cited by the Examiner, claim 53 recites a method that includes:

      generating an electronic catalog, the electronic catalog including

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source information identifying a source entity of the electronic catalog, the source information including an source entity name, source entity contact data and a source entity digital certificate;

validity information indicating a time during which the electronic catalog is valid;

ordering method information, the ordering method information including a URL indicating a location where a transaction may be initiated;

at least one object entry including product identification information, the product identification information including a SKU, product name, manufacturer, model number and base unit price, the at least one object entry further including a URL indicating a location where additional product information may be obtained;

a digital signature, the digital signature based on the source information, validity information, ordering method information, and at least one object entry;

receiving a request for the electronic catalog from a remote location;

transmitting the electronic catalog to a remote location.

As noted in the discussion of the cited references above, none of the list of references cited by the Examiner (Perkowski, MacKenzie, Carlsson, Schumacher and Heck) either taken individually or in any combination, teach or suggest all of the elements of claim 53. For example, none of the cited references teaches or suggests generating an electronic catalog that includes at least one object entry including product identification information, the product identification information including a SKU, product name, manufacturer, model number and base unit price, the at least one object entry further including a URL indicating a location where additional product information may be obtained, such as recited in claim 53. The absence of these elements (or others) from the prior art precludes any anticipation or obviousness of claim 53. Applicant therefore believes claim 53 to be patentable over Perkowski, MacKenzie, Carlsson, Schumacher and Heck, and respectfully requests that the Examiner indicate the allowance of claim 53. As claims 54 and 55 depend from claim 53, and therefore include all of the limitations of claim 53, Applicant believes these claims to be patentable over the references cited by the Examiner for at least the same reasons as claim 53, and therefore respectfully requests that Examiner indicate allowance of claims 54 and 55 as well.

III   Conclusion

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In view of the foregoing, Applicant respectfully submits that the pending claims are in condition for allowance. Reconsideration and allowance are respectfully requested. If there are any outstanding issues which need to be resolved to place the application in condition for allowance, the Examiner is invited to contact Applicant's undersigned representative by phone at the number indicated below to discuss such issues. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to deposit account number 07-2347. With respect to this application, please charge any other necessary fees and credit any overpayment to that account.

Respectfully submitted,

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Joseph R. Palmieri
Reg. No. 40,760

Verizon Corporate Services Group Inc.
600 Hidden Ridge Drive
Mail Code: HQE03H14
Irving, Texas 75038
(972) 718-4800

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